

APR 24 2006

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10008291-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Theresa A. Burkes et al.

Confirmation No.: 9288

Application No.: 09/888,941

Examiner: M. Brooks

Filing Date: 06/25/2001

Group Art Unit: 3629

Title: Method for Determining a Warranty Start Date

Mail Stop  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
( ) No additional fee  
(X) Other: Interview Summary; Copy of Notice of Non-Compliant Amendment

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	1ST MONTH \$120.00	2ND MONTH \$450.00	3RD MONTH \$1020.00	4TH MONTH \$1590.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

(X) I hereby certify that this paper is being transmitted  
to the Patent and Trademark Office facsimile  
number (571) 273-8300 on 4/24/2006  
Number of pages: 19

Typed Name: Natalie King

Signature:

Theresa A. Burkes et al.

By

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg. No. 39,833

Date: 4/24/06

Telephone No.: (509) 624-4276

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Appeal No. 2003-2088, regarding Application 08/093,516. A copy of the opinion may be found at <http://www.uspto.gov/web/offices/dcom/bpai/prec.htm>. Applicant submits the 101 rejection is improper in view of this decision as well as the following authority.

Applicant respectfully submits precedent of the Court of Appeals for the Federal Circuit makes clear the subject claims recite statutory subject matter. Applicant to the holdings of *In re State Street*, 47 USPQ2d 159 (Fed. Cir. 1998) and *In re AT&T*, 50 USPQ2d 1447 (Fed. Cir. 1999). Further, 35 USC 101 states any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, is patentable. As recognized by the *State Street* court, the repetitive use of the term "any" in section 101 shows *Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101*. The court further stated that it is improper to read limitations into section 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. *See State Street*, 47 USPQ2d at 1600.

The Federal Circuit has stated in the above-recited opinions that claims directed toward a useful, concrete or tangible thing or result recite statutory subject matter. *In re Alappat*, 33 F.3d at 1526, 31 USPQ2d 1545 (Fed. Cir. 1994) requires examination of the claims to determine whether the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a law of nature or an abstract idea (non-statutory), or if the mathematical concept has been reduced to some practical application rendering it useful (statutory). *In re Alappat*, 31 USPQ2d at 1544.

Accordingly, Applicant's claims are clearly not merely reciting an abstract idea but rather recite practical applications which are useful, concrete and tangible results (i.e., the defining, generating and storing of claim 1 and the defining, searching, generating, encrypting, storing and outputting of claim 13) which are held to recite statutory subject matter. Applicant submits that abstract ideas are defined in *AT&T* as *mathematical subject matter which stands alone and which has not been reduced to some type of practical application*. *AT&T*, 50 USPQ2d at 1451. Applicant submits that in view of the above, the subject matter of the present application is not mathematical subject matter which stands alone but

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rather has clearly been reduced to practical applications which are useful. Applicants respectfully request withdrawal of the 101 rejections for at least the above-mentioned reasons.

Referring to the double patenting rejections, Applicant submits a terminal disclaimer herewith and respectfully request withdrawal of the double patenting rejection in view of the submitted terminal disclaimer.

Referring to the prior art rejections, Applicants respectfully submit the use of Muta as prior art in support of the obviousness rejections is improper under Section 35 U.S.C. §103(c). More specifically, as evidenced by the Statement of Common Ownership submitted herewith, Muta and the above-referenced application are commonly owned. MPEP §706.02(I)(3) (8<sup>th</sup> ed., rev. 3) states that Muta is disqualified when:

(a) proper evidence is filed (see the statement of common ownership filed herewith);

(b) the reference qualifies as prior art under 35 U.S.C. §102(e) for applications filed on or after November 29, 1999; and

(c) the reference is used in an obviousness rejection under 35 U.S.C. §103(a).

The Muta reference qualifies as a §102(e) reference and is used in an obviousness rejection against some of the pending claims. Moreover, the above-referenced application was filed after the November 29, 1999 deadline. Accordingly, the requirements of MPEP §706.02(I)(3) (8<sup>th</sup> ed., rev.3) and §103(c) are met and the obviousness rejection against the claims based on Muta is inappropriate and should be withdrawn.

More specifically, referring to claim 1, the method recites limitations of previously pending claim 7. Applicants respectfully submit the 103 rejection against previously pending claim 7 was improper under 103(c) and Applicants respectfully request allowance of claim1 for at least this reason.

The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by

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the cited art.

Referring to claim 13, Applicants respectfully submit the 103 rejection of claim 13 is improper under 103(c) and Applicants respectfully request allowance of claim 13 in the next Action.

The claims which depend from independent claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 15, the method recites limitations of previously pending claim 16. Applicants respectfully submit the 103 rejection against previously pending claim 16 was improper under 103(c) and Applicants respectfully request allowance of claim 15 for at least this reason.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 21, Applicants respectfully submit the 103 rejection of claim 21 is improper under 103(c) and Applicants respectfully request allowance of claim 21 in the next Action.

Applicants hereby include new claims 22-26 which include limitations of originally pending claims 5, 6, 18, 19, and 20 and the limitations of the respective base claims thereof. New claims 22-26 are believed to be allowable pursuant to 35 USC 103(c) discussed above and allowance of the claims is respectfully requested in the next Action.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as*

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practicable. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,  
Theresa A. Burkes et al.

By: 

James D. Shaurette

Reg. No. 39,833

Date: 4/24/06

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Serial No.: 09/888,941  
Amendment A



# RECEIVED

## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,941	06/25/2001	Theresa A. Hurkes	10008291-1	9288
<div style="display: flex; justify-content: space-between;"> <div>           7590  <b>HEWLETT-PACKARD COMPANY</b>            Intellectual Property Administration            P.O. Box 272400            Fort Collins, CO 80527-2400         </div> <div>           EXAMINER            BROOKS, MATTHEW L.         </div> </div>				
			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

**Notice of Non-Compliant  
Amendment (37 CFR 1.121)**

Application No.

09/888,941

Examiner

Matthew L. Brooks

Applicant(s)

BURKES ET AL.

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 12/19/2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☐ E. Other: \_\_\_\_\_.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4): \_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

**TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the entire corrected amendment must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1. to 4. are checked, the correction required is only the corrected section of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

**Failure to timely respond** to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or  
Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

U.S. Patent and Trademark Office

Part of Paper No. 032006